

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Patent Application No. 09/900,674

Confirmation No. 6698

Applicant: Nyhan, et al.

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Examiner: Boyce, Andre D.

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APPELLANTS' REPLY UNDER 37 C.F.R. SECTION 41.41

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
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Dear Sir:

This paper is filed in response to the Answer mailed on **March 5, 2009**. Appellants hereby respectfully request allowance of the pending claims for the reasons set forth in Appellants' Brief filed on November 20, 2009, and for the further reasons stated herein.

Status of Claims

Claims 1, 3, 5-17, 21-24 and 26-33 stand finally rejected, and these rejections are presently being appealed.

Claims 2, 4, 18-20, and 25 stand presently canceled.

A complete listing of these claims appears in the Claims Appendix.

Grounds of Rejection to be reviewed on Appeal

The grounds of rejection to be reviewed on appeal are the grounds stated in the Final Office Action mailed on August 24, 2007.

1. Claims 1, 3, 5-7, 11-17, 26-27, and 33 are rejected as obvious under 35 U.S.C. §103(a) over Smith et al. U.S. Pub. App. 2002/0128898 (Smith) in view of de Ment U.S. Pat. No. 6,728,755 (de Ment).
2. Claims 8-10, 21-24, and 28-32 are rejected as obvious under 35 U.S.C. §103(a) over Smith in view of de Ment and Winn U.S. Pat. No. 6,901,424 (Winn).

Argument in Reply to the Answer

Appellants have carefully reviewed the Examiner's Answer. The combined teachings of the prior art upon which the Final Office Action and Answer rely do not disclose *each of the recited elements* within the independent claims. The Final Office Action has thus not established a *prima facie* case of obviousness with respect to the presently pending claims. Appellants therefore request reversal of the rejection of the presently pending claims in view of Appellants' arguments presented in their Appeal Brief and reiterated herein below in response to the Answer.

The Grounds of Rejection Section (9) of the Answer, beginning at page 3 and ending at page 17, restates the grounds recited in the Final Office Action from which the present appeal was taken. Appellants have addressed the Answer's grounds for rejection in the previously filed appeal brief, and thus Appellants will not repeat these arguments. However, the discussion below reiterates points previously made by Appellants to address points raised in the Answer's Response to Argument (Section 10, Answer, pp. 17-26).

Smith's teachings differ fundamentally from the presently claimed invention. In particular, the recited elements of the claimed invention define a system/method that facilitates preventing excessive presentation of *solicitations to take an on-line survey* – in other words it restrains how frequently a user is *invited* to take a survey. On the other hand, Smith discloses a system for *selecting a particular survey* for presentation to a user – including use of cookie data identifying previously *completed surveys*. Smith's disclosed system/method thus avoids presenting a same *survey* to a user multiple times. Smith, in contrast to Appellants' claimed invention, provides no mechanism for *limiting presentations* of survey *solicitations*. The Answer does not address this shortcoming in Smith's teachings with regard to Appellants' claimed invention.

For the reasons presented herein, the combined teachings of Smith, de Ment, and Winn do not render the claimed invention obvious.

1. Rejection of Claims 1, 3, 5-7, 11-17, 26-27 and 33 As Obvious Over Smith in View of de Ment

Claims 1, 3, 5, 12, 13, 14, 16, 26, 27, and 33

Appellants request reversal of the final rejection of **claim 1** as obvious over Smith in view of de Ment. Appellants previously identified four elements recited in claim 1 that are neither disclosed nor suggested by the combined teachings of Smith and de Ment.

The recited "issuing" step

The claimed "issuing" step recites actions performed by the user computer to obtain an *on-line advertisement* from an ad server in association with the user computer processing a *previously received web page*. See, FIG. 1, Step C. The claimed issuing step unequivocally identifies a cause/effect relationship between the initial "receiving" step and the responsive "issuing" of "a request to an ad server" that occurs when the "received" web page is processed by the user computer.

The Answer apparently agrees with Appellants' understanding that Smith discloses, at paragraphs 54-55, 58, 118, 122-125, and 145-146 (cited in the Answer) banner ads *delivered within the initially downloaded web page*. In Smith, the banner ads downloaded in the *initially provided web pages* contain the links to surveys. See also, Smith, paragraph [0058]. There is thus no disclosure in Smith regarding Appellants' claimed issuing, by a user computer, *a request to an ad server in association with processing a previously received web page*.

The continued rejection of claim 1, at the bottom of page 18 and top of page 19, thus rests upon the Answer improperly disregarding the causal/serialized relationship between Appellants' recited "receiving" and "issuing" steps. The Answer agrees that Smith discloses downloading the advertisements *with* the initially provided Web page. Smith does NOT disclose the user computer issuing a request to an ad server for an on-line advertisement AFTER initially receiving the Web page that will display the on-line advertisement. Therefore, Smith does not disclose the claimed "issuing" step.

The recited "providing" step

The Answers' misinterpretation of the "issuing" step carries over to its analysis of the recited "providing" step.

Appellants' claimed "providing" step identifies particular additional computer-readable instructions contained within the block of data provided by the ad server (in response to the "issuing" step arising from the "receiving" step) that facilitate decision-making steps for determining *whether to present* an on-line survey *solicitation* (emphasis added) – NOT THE SURVEY ITSELF. Appellants' disclosure (see Fig. 1, Steps J and K and associated written description) unequivocally distinguishes: (1) the act of presenting a solicitation to take a survey from (2) the subsequent act of presenting the survey *in response to a user's affirmative response to the on-line solicitation*.

Smith, in contrast, discloses determining *which survey* a user will be presented in response to a request from the user computer after processing the banner ad containing a survey solicitation downloaded with the *initially provided Web page*. The banner ad containing the survey solicitation is downloaded without regard to any previous exposure by the current user to previous *solicitations* to take a survey.

The Answer has not identified any teaching in Smith of the claimed "determining whether to present an on-line survey solicitation" in Appellants' recited providing step. The Answer identifies portions of Smith (paragraphs 0121-0124) relating to *selecting a particular survey* rather than determining *whether to present an on-line survey solicitation*.

Moreover, the Answer does not even address Appellants' previously raised argument that Smith does not disclose providing the additional instructions *via the Ad Server* in response to a request issued by the user computer (see, "issuing" step discussed above). Therefore, Smith does not disclose the recited "providing" step – in particular as it relates to the previously discussed "issuing" step.

The recited "accessing" step

Appellants' claimed "accessing" step recites the additional action of reading a timestamp value to determine a period of time that has passed since a user was last *solicited to take a survey*. The accessing step thus ensures that an unwilling user will not receive repeated *solicitations to take a survey*.

In contrast to the recited "accessing" step, Smith discloses reading a cookie to determine whether a user has *taken a survey*. Since Smith merely records *completed surveys*, there is no way for Smith's system to determine a time duration since a last *survey solicitation* was submitted to the user computer. Smith thus does not disclose a mechanism that can readily identify a user that has declined a series of previously submitted solicitations to take a survey. Instead, Smith merely prevents users from *taking multiple surveys* of a same type.

Moreover, addressing the Answer's grounds for combining Smith and de Ment, the Answer has not demonstrated why a survey administrator (in Smith's disclosed arrangement) would ever want a user to take a particular survey more than one time. Therefore, a *timestamp*, disclosed in de Ment, would not be considered useful in Smith's on-line survey presentation method because merely noting that a particular survey was taken is sufficient to prevent users from taking a survey multiple times and a timestamp is superfluous. For this additional reason the combined teachings of Smith and de Ment do not render the claimed invention obvious.

The recited "executing the additional ... instructions" step

Appellants' claimed "additional computer-readable instructions" are embedded within a downloaded *block of data from an ad server* and "facilitate decision-making steps for determining whether to present an on-line survey solicitation via the browser client." The "executing" step, *properly construed* (i.e., paying proper attention to antecedent basis) in combination with the previously recited "issuing", "providing", and "accessing" steps, requires: (1) downloading, within an ad data block from an ad server, additional instructions for determining *whether* to present an *on-line survey solicitation*, and (2) executing the additional instructions if a timestamp accessed on the user computer indicates a sufficient period of time has passed since a previous *on-line survey solicitation*.

The Answer, at page 21, lines 6-11, recites the literal words of the recited "executing" step. However, its analysis that follows completely disregards the relationships between the claim elements in the "executing" step that were recited previously in the preceding claim steps. As such, the subsequent analysis provided on pages 21 and 22 disregards previously established relationships between claim elements in the other recited steps of claim 1. As a result, the Answer does not identify any teaching in de Ment or Smith that corresponds to the recited time stamp identifying a period of time that has passed since an "on-line survey solicitation" was previously presented on the user computer. De Ment instead measures a time period since a last *survey* was presented to a user.

Moreover, de Ment's "decision step 216" does not lead to executing additional instructions embedded within a *data block downloaded from an ad server*. In fact, neither Smith nor de Ment discloses such instructions being downloaded in a data block from an ad server. Appellants renew their previous request that: **"In the event the rejection is not withdrawn/reversed, Appellants specifically request identification of a teaching within either Smith or de Ment that such additional instructions are downloaded in a data block from an ad server."**

Appellants have identified several elements of **claim 1** that are simply not disclosed in either Smith or de Ment. Furthermore, the Answer does not present a viable reason for one skilled in the art to modify Smith to include a timestamp (indicating the last time a user *participated in a survey*) since Smith does not indicate any desirability in having users retake a survey (and in fact discloses just the opposite). The rejection of **claim 1** as obvious over Smith in view of de Ment should be reversed.

Appellants seek reversal of the other independent and dependent claims grouped with claim 1 (including each of the independent claims) in this section for at least the reasons recited for claim 1.

The Rejection of Claim 6

Appellants specifically seek reversal of the rejection of **claim 6**. Both Smith and de Ment record *actual completions of surveys*. Unless a user completes an on-line survey, neither Smith nor de Ment will store an updated cookie. Thus, neither Smith nor de Ment discloses storing a cookie indicating that a *survey solicitation* was presented on the user computer.

The Rejection of Claims 7 and 15

Appellants specifically seek reversal of the rejection of **claims 7 and 15**. Claims 7 and 15 recite elements relating to decision-making with regard to presentation of an "on-line survey solicitation." The Answer disregards the distinction between a "survey solicitation" (i.e., an invitation to take a survey) and the actual survey taken by users.

Moreover, the Answer has not addressed Appellants' further point that paragraphs [0129-0130] of Smith disclose limiting a "quantity" of surveys taken by a particular user rather than a "frequency" (how often) with which solicitations are presented to a particular user computer.

The Rejection of Claim 11

Appellants seek reversal of the rejection of **claim 11**. Appellants note that the Answer's argument (regarding the re-phrasing of the recited claim elements) does not consider "context" provided by Appellants' description in view of antecedent basis for terms within the claim. The Answer disregards the context provided by Appellants to aid understanding of the claim element (instead of reading the claim element in a vacuum – which lead to the Answer's inconsistent application of the references to the claim elements).

Appellants thus reiterate that neither Smith nor de Ment discloses linking the survey questions to a product or service advertised in the on-line advertisement provided in the block of data downloaded from the ad server (as called for in claim 11). The portions of de Ment referenced at page 7 of the Final Office Action neither discloses nor suggests the survey questions are linked to an *on-line advertisement* contained within the previously provided block of data from the ad server.

Claim 17

Appellants specifically seek reversal of the rejection of **claim 17**. The rejection of claim 17, like the rejection of claim 1, does not distinguish between an initially downloaded web page and a subsequently requested ad block, by a user computer, from an advertisement server.

2. Rejection of Claims 8-10, 21-24, and 28-32 As Obvious Over Smith in View of de Ment and Winn

Claims 8-10, 21-24, and 28-31

The Answer is unresponsive to the points raised previously by Appellants' Brief, and instead the Answer seeks to divert attention from the absolute absence of any teaching in the prior art regarding the recited claim elements by again attacking Appellants' provision of context for the recited claim elements in view of both the disclosure and antecedent claim elements.

Thus Appellants repeat there previous request for reversal of the final rejection of **claim 8** as obvious over Smith in view of de Ment and Winn. The Final Office Action and Answer do not identify any teaching in any of the three cited references directed to Appellants claimed element of changing a frequency parameter in accordance with an amount

of time remaining in a campaign. The Final Office Action states, without confirmation in the teachings of the prior art, that changing the frequency in response to the amount of time remaining in a campaign leads to *more efficiently gathering information*. See Final Office Action, page 11, lines 4-7.

The Final Office Action has not provided a single reference supporting its bald assertion at page 11, lines 4-7, that Appellants' claimed time-based frequency determination improves information gathering. Appellants submit that the time-based frequency parameter determination does not necessarily improve information gathering. Rather, such adjustment potentially leads to an undesirably high frequency value arising from a need to meet a specific campaign deadline. There are many factors that can potentially be used to dynamically specify the frequency parameter. Neither the Final Office Action, at page 11, lines 6-7, nor the Answer explains how changing the frequency over time defines "the goals and objectives of the data to be collected" which, in turn, enables a survey campaign administrator to "more efficiently gather information from users." The rejection of claim 8 is instead the product of a hindsight deconstruction of Appellants' claimed invention.

Claim 32

Appellants specifically seek reversal of the rejection of claim 32 as obvious over Smith in view of de Ment, Winn and Official Notice. URLs are indeed well known. However, nowhere in the cited references is there a suggestion to append the randomly generated value to the URL address identifying the location of the sender of a survey request to the survey logic server that ultimately determines whether to provide the survey to the requesting user computer. The Final Office Action merely states that appending a random number to the sender's URL efficiently links the sender to the survey logic server. However, there is no citation to the prior art supporting this bald assertion. The rejection of claim 32 is another case of using impermissible hindsight to guide a determination of "obviousness".

The Answer, rather than concede the use of impermissible hindsight, offers additional reasoning beginning at the bottom of page 24 and continuing through page 25. Appellants agree that a URL can comprise a series of numbers. However, such teaching does not explain why one skilled in the art at the time of the invention would even contemplate the claimed appending of the random number to the URL. Appellants invite a further explanation, if possible, of the statement "in order to more efficiently gather information from users of the

system by defining the goals and objectives of the data to be collected." (See, Answer, page 25, lines 2-3).

The statement at page 25, lines 3-6, makes no sense at all since there does not appear to be any relationship between a random number attached to a URL and linking to files contained on another computer.

Appellants request identification of a reference in support of the rejection of claim 32 in the event the rejection of claim 32 is not withdrawn/reversed.

Finally, the Office Action attempts to apply KSR to the rejection of claim 32. Even under the relaxed obviousness analysis proposed by KSR, there is still a requirement to provide some reason for making a modification to a prior art reference to render Appellants' claimed invention. However, the Answer clearly uses hindsight to piece together the diverse teachings to render a combination that is clearly not intended by the teachings of the prior art references taken as a whole. There is simply no suggestion of either a need or benefit of appending the recited random number to the URL in any of the prior art references.

Conclusion

The claimed invention facilitates resubmitting, to a user computer, an invitation to take a survey assuming a sufficient amount of time has passed since a previous *solicitation to take a survey*. Appellants have identified substantial differences between the invention recited in independent claims 1, 13 and 17 and the disclosure of the references cited in the Final Office Action. The dependent claim elements address "dynamic" aspects of the disclosed survey method/system that facilitate "tuning" a survey campaign. None of these advantageous aspects of the claimed invention are disclosed or suggested in the cited references. Thus, Appellants request withdrawal/reversal of the obviousness rejection of each of the presently pending claims.

Respectfully submitted,



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Claims Appendix

1. A method for conducting an on-line survey in association with presentation of an on-line advertisement by a browser client, the method comprising:

receiving, by a user computer hosting the browser client, a web page configured to display an on-line advertisement;

issuing, by the user computer in association with processing the received web page, a request to an ad server, for a block of data comprising computer-readable instructions for presenting the on-line advertisement via the browser client;

providing, by the ad server in response to the issued request from the user computer, the block of data including computer-readable instructions for presenting the on-line advertisement and the block of data further including additional computer-readable instructions that facilitate decision-making steps for determining whether to present an on-line survey solicitation via the browser client;

accessing, on the user computer, a timestamp value indicative of a period of time that has passed since the on-line survey solicitation was previously presented by the browser client; and

executing the additional computer-readable instructions if the timestamp value indicates passage of a period of time satisfying a prescribed wait period between consecutive presentations of the on-line survey solicitation by the browser client on the user computer.

3. The method of claim 1, wherein the accessing step comprises receiving cookie data from the browser client indicative of a previous presentation of the on-line survey solicitation.

5. The method of claim 1, further comprising sending the block of data, including the additional computer-readable instructions, to the browser client over a computer network.

6. The method of claim 1, further comprising:

presenting the on-line survey solicitation thereby soliciting the user to take the on-line survey,

generating, in association with the presenting step, cookie data including the timestamp value to indicate that the on-line survey solicitation was presented by the browser client; and

sending the generated cookie data over a computer network to the browser client.

7. The method of claim 1, further comprising:

executing the additional computer-readable instructions to perform steps of:

referencing a frequency parameter that influences the frequency of presenting the on-line survey solicitations; and

determining whether or not to present the on-line survey solicitation via the browser client based, in part, on the frequency parameter.

8. The method of claim 7, wherein the on-line survey solicitation is presented as part of a campaign, wherein the frequency parameter has a value that is at least partially a function of an amount of time remaining in the campaign, the method further comprising calculating the value of the frequency parameter according to an algorithm that incorporates the amount of time remaining in the campaign.

9. The method of claim 7, wherein the on-line survey solicitation is presented as part of a campaign, wherein the frequency parameter has a value that is at least partially a function of an amount of time remaining in the campaign, the method further comprising determining the value of the frequency parameter by referencing a look-up table that correlates a plurality of possible times remaining in the campaign with corresponding possible frequency values.

10. The method of claim 1, further comprising executing the additional computer-readable instructions to perform steps of:

generating a random number;

determining whether the random number falls within a set of numbers that correspond to a frequency with which the on-line survey solicitation is presented via browser clients;
and

presenting the on-line survey solicitation based on the determining step.

11. The method of claim 1, further comprising:

presenting the on-line survey solicitation as a pop-up window; and

in response to activation of a link within the pop-up window, sending a web page to the browser client comprising questions regarding a product or service advertised in the on-line advertisement.

12. The method of claim 1, further comprising:

presenting the on-line survey solicitation as a pop-up window; and

in response to activation of a link within the pop-up window, sending a web page to the browser client comprising questions regarding a product or service that is not advertised in the on-line advertisement.

13. A method for soliciting a user of a user computer to take an on-line survey, the user computer being linked to a computer network and running a browser program, the method comprising:

receiving, by an advertisement server, a request issued by the browser for one or more files comprising an on-line advertisement;

providing, by the advertisement server to the user compute in response to the request issued by the browser, the one or more files comprising the on-line advertisement and in addition including further computer-readable instructions that facilitate decision-making steps for determining whether to present an on-line survey solicitation via the browser;

accessing, on the user computer, cookie data for the browser including a timestamp regarding previous presentation by the browser of the on-line survey solicitation; and

executing the further computer-readable instructions if the timestamp value indicates passage of a period of time satisfying a prescribed wait period between consecutive solicitations on the user computer to take the on-line survey.

14. A computer-readable medium having stored thereon computer-readable instructions for performing the method of claim 13.

15. The method of claim 13, wherein the one or more requested files comprise computer-readable instructions for displaying the on-line advertisement, and wherein the further computer-readable instructions call a routine that decides whether or not to solicit the user to take the on-line survey based on a frequency parameter, the frequency parameter being indicative of a probability that, in response to the selectively modifying step, the on-line survey solicitation will be submitted for presentation by the browser.

16. The method of claim 15, further comprising:

sending further script to the browser comprising instructions for displaying a pop-up window that, when clicked on by the user, causes the browser to download a web page that includes the on-line survey.

17. A system for conducting an on-line survey, the system comprising:

a client computer for interacting with a user;

a web server in communication with the client computer;

an advertisement server;

a survey logic server in communication with the client computer; and

computer-readable instructions for:

requesting a web page to be sent from the web server to the client computer, the web page including a reference to an on-line advertisement to be presented on the client computer;

requesting, by the client computer the on-line advertisement from the advertisement server for presentation on the client computer; and

sending an on-line survey solicitation associated with the on-line advertisement from the survey logic server to the client computer based at least in part on a stored timestamp value on the client computer indicative of a period of time that has passed since a previous presentation of the on-line survey solicitation on the client computer.

21. The system of claim 17, wherein the sending step comprises:

invoking a routine at the survey logic server that compares a random number to a set of values based on a frequency parameter to determine whether to send the on-line survey solicitation to the client computer.

22. The system of claim 21, wherein the on-line survey solicitation is presented as part of a campaign, and wherein a value of the frequency parameter is at least partially a function of elapsed time in the campaign.

23. The system of claim 22, wherein the frequency parameter is determined according to an algorithm.

24. The system of claim 22, wherein the frequency parameter is determined by referencing a look-up table.

26. The system of claim 17, wherein the advertisement server adds first computer-readable instructions, for invoking a decision routine, to the advertisement data when consideration is to be given to sending the on-line survey solicitation to the computer.

27. The system of claim 26, wherein the survey logic server provides the first computer readable instructions to the ad server.

28. The method of claim 1 wherein the decision-making steps comprise generating a random number on the user computer; and wherein the method further comprises:

applying a frequency parameter value to the random number to determine whether to present a survey invitation on the user computer.

29. The method of claim 28 wherein the frequency parameter value is specified by a survey logic server.

30. The method of claim 29 further comprising the step of changing the frequency parameter value during a survey campaign.

31. The method of claim 29 wherein the executing step comprises providing the random number to the survey logic server, and wherein the survey logic server performs the applying step.

32. The method of claim 31 wherein the random number is appended to a URL used by a browser on the user computer to contact the survey logic server.

33. The method of claim 1 wherein the prescribed wait period is specified by a survey logic server.